

REMARKS

STATUS OF THE CLAIMS

Claims 1, 3-11, 13-25, 27-35, and 37-46 are pending. By this Amendment, claims 1, 4, 11, 18, 25, 28, 35, 38 and 45 have been amended and claims 2, 12, 26 and 36 have been canceled. No new matter has been added.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 3-11, 13-25, 27-35, and 37-46 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 3-11, 13-25, 27-35, and 37-46 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, it is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

REJECTIONS UNDER 35 U.S.C. § 103

A. The Examiner has rejected claims 1-46 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,942,470 to Norman et al. (“Norman”).

Although Applicant disagrees with the Examiner’s position that Norman discloses or suggests an additive package which “yields a lubricating oil having sulfur content less than about 0.3 wt%,” independent claims 1, 11, 25 and 35 have been amended to recite that the claimed additive package also yields “a phosphorus content of less than about 0.11 wt%” in the lubricating oil. Norman clearly does not teach or suggest the invention as presently recited in independent claims 1, 11, 25 and 35.

The additive composition disclosed in Norman is specifically designed to suppress noise and vibration (col. 1, Ins. 40-42). Norman does not discuss having such low sulfur and

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phosphorus content in the lubricating oil as claimed in this application, nor does Norman recognize the significance of or desire to achieve the same.

The feature describing the phosphorus content in the independent claims was previously recited in dependent claims 2, 12, 26 and 36, *inter alia*. Neither the Office Action issued February 15, 2006 nor the Office Action issued July 27, 2005 addresses this feature. Moreover, Applicant notes that Norman is silent in this regard as well. As such, compositions recited in independent claims 1, 11, 25 and 35 are patentably distinguishable over Norman.

The Office Actions dated February 15, 2006 and July 27, 2005 also fail to address the subject matter recited in claims 4, 18, 28 and 38. As recited in these claims, the lubricant oil has “an ash content less than about 1.2 wt%,” in combination with the sulfur and phosphorus content recited in their respective independent claims. Again, such combination of features is not discussed, contemplated, or suggested in Norman. Accordingly, this claimed combination provides the above-identified claims with an additional ground of patentability over Norman.

Independent claim 45 recites that the lubricating oil has at least two of the following properties: “a sulfur content less than about 0.3 wt%, a phosphorus content of less than about 0.11 wt%, and an ash content less than about 1.2 wt%.” Because Norman does not teach or suggest either the claimed phosphorus content or the claimed ash content, Norman thus does not teach or suggest any combination of the components recited in the claim. As such, independent claim 45 is also allowable over Norman.

As an ancillary matter, *Ex parte Wu*, relied upon by the Examiner to support her argument that the sulfur-containing extreme pressure agent, component (i), could be eliminated from Norman, is inapplicable to the present case. A primary goal of Norman is to “provide additive systems capable of rendering improved service for long periods of time.” Col. 1, lns. 35-36. Component (i) provides this function, and is an integral element of the disclosed composition. To eliminate component (i) from Norman would destroy the invention for its intended purpose, and thus it would not have been obvious to do so. *See MPEP 2143.01 V; Ex parte Kaiser*, 189 U.S.P.Q. 816 (Bd. Pat. App. & Inter. 1974) (omission of feature claimed in reference is not obvious if such omission clearly contravenes the objective taught by the reference); *In re Gorden*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

The antiwear agent of component (i) is recited in each of Norman's independent claims, and the reference never teaches or suggests that this component can be eliminated. On the other hand, Norman does disclose that components (iv), (v), (vi) and those discussed in column 19, lines 30-65 are all optional. Thus, it would be improper to modify Norman to eliminate component (i), absent any suggestion or motivation provided in the reference to do so. *ACS Hospital Systems, Inc. v. Monefiori Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929,933 (Fed. Cir. 1984) ("If modifications to a prior art reference are required to arrive at a prima facie case, the prior art must supply the motivation or incentive to make the modifications."); *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430,1432 (Fed. Cir. 1990).

For each of the reasons discussed above, claims 1, 3-11, 13-25, 27-35, and 37-46 are not rendered obvious by Norman. Accordingly, withdrawal of this rejection is respectfully requested.

B. The Examiner has rejected claims 25-46 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,342,531 to Walters et al. ("Walters").

Walters discloses a lubricant oil additive composition which strives to increase the wear resistance of a polyalkylene glycol base oil. In this regard, Walters' composition includes a sulfur-containing antiwear or extreme pressure agent, an amine salt of a partially esterified monothiophosphoric acid, an amine salt of a partially esterified phosphoric acid, and for example, a sterically hindered phenolic and/or amine antioxidant.

The Examiner asserts that "the amount of sulfur present in the compositions disclosed by Walters **may be** within the claimed limit of less than 0.3 wt.%" *See* Office Action dated February 15, 2006, p. 6 (emphasis added). Walters provides no such disclosure, and is, in fact silent as to the composition of sulfur in either the additive combination or the resulting lubricating oil. *In re Rijckaert*, 9 F.3d 1531, 1533 (Fed. Cir. 1993) (holding that "the statement that the relationship is 'probably satisfied' by the prior art, is speculative and therefore does not establish a prima facie case of unpatentability.").

Presently, independent claims 25 and 35 each recite an additive package which yields "a sulfur content less than about 0.3 wt% and a phosphorus content of less than about 0.11 wt%." Walters provides no teaching or suggestion of either of these features, much less both of them

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together. Walters also lacks any mention of "an ash content of less than about 1.2 wt%," as recited in claims 28 and 38. Similarly with the claimed combination just mentioned, Walters does not teach or suggest any combination having two of the three claimed component amounts of sulfur, phosphorus and ash, as recited in independent claim 45. Thus, each of independent claims 25, 35 and 45 patentably distinguish over Walters.

The claimed phosphorus and ash compositions were not addressed in either of the Office Actions issued in this case, but have been continuously present in the claims from the time this application was originally filed. Because it has been demonstrated that Walters cannot render obvious any of independent claims 25, 35 and 45, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection.

**FEES**

It is believed that there are no fees associated with this filing. However, in the event the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 05-1372. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 05-1372.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration of this application and the timely allowance of the pending claims.

Respectfully submitted,



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